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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,077	11/27/2001	Jeffry J. Grainger	021737-000710US	1100
20350 7590 11/26/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER MOONEYHAM, JANICE A	
			ART UNIT 3629	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/996,077

Applicant(s)

GRAINGER, JEFFRY J.

Examiner

Janice A. Mooneyham

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims.

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the applicant's communication filed on September 5, 2007, wherein:

Claims 1-17 are currently pending;

Claims 1, 13 and 14 have been amended.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 13 and 14 have a limitation of "executing said first workflow rule from said server system to generate a message requesting approval from said second client system to prepare a patent application from said first invention disclosure and to communicate said message to said second client system". It is not clear what applicant is trying to claim in this limitation. Your are requesting approval from the second client system and communicate a message to the second client system. Is there only one message or two messages?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 8-9, and 13-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Serbinis et al. (US 6,584,466) (hereinafter referred to as Serbinis).

Referring to Claims 1-4, 8-9, and 13-17 :

Serbinis discloses a computer-implemented method and server system for managing documents:

a server system (server computer Figure 1A) **comprising a processor** (inherent), a database (1A (25)), **a memory for storing a program** (col. 4, line 61 thru col. 5, line 15), wherein the server system communicates with client systems over the Internet (Figure 1A);

storing a workflow rule on a server system and executing said workflow rule from said server system to generate a message, the message is an alert sent over the Internet (col. 2, lines 52-57 an Internet document management system and methods that permit users to access a plurality of services supported by a common Internet database, including document storage, collaborative file sharing and **workflow**, document delivery and document distribution; col.. 3, lines 25-42 workflow service; col. 4, lines 16-28; col. 6, lines 19-34; col. 9, lines 50-66; col. 9, lines 50-53 notification server 35 generates notification messages to the Authorized Users informing those Users that the document is available in store 30; col. 10, lines 35-44;

col. 18, lines 25-27 Notification messages are generated by notification server 35 in response to various user events);

storing and uploading a first document in a database accessible by said server system (col. 5, lines 26-62);

receiving, at said server system, a first signal from a first client system (col. 5, lines 63-col. 6, line 1);

tracking one or more elapsed times selected from the group consisting of a time elapsed from a beginning of the workflow, a time elapsed during performance of each of one or more tasks of the workflow and time elapsed between performance of each of one or more tasks of the workflow (col. 13, lines 51-57).

The Examiner notes the following as to applicant's claim limitations:

1. First, the fact that the document relates to a patent application, or that the document stored is a first invention disclosure, or that the message generated is a message that request approval to prepare a patent application or request approval to prepare a patent application is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-

85,217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data identifying the document as relating to a patent application or invention disclosure or the content of the messages transmitted adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying the document as relating to a patent application or invention disclosure or that the content of the messages transmitted does not functionally relate to the substrate and thus does not change the steps of the method

as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

2. As to the limitation of *storing a first workflow rule on a server, wherein the workflow rule defines a workflow **that causes upon receipt of a first signal** indicating a request to submit an invention disclosure for approval, the server system to generate a message that request approval to prepare a patent application for said invention disclosure and route said message to a second client system based on the first workflow rule* that as claimed, the claim limitation only requires "storing a workflow rule on a server system. The fact that the rule defines a workflow that causes upon receipt of a signal the server to generate a message is not a positive recitation of a signal being sent. Thus, the language *that causes upon receipt of a first signal indicating a request to submit an invention disclosure for approval, the server system to generate a message that request approval to prepare a patent application for said invention disclosure and route said message to a second client system based on the first workflow rule* further defines the workflow rule. However, until there is an active step of sending and receiving a signal, the description of the workflow rule is non-functional descriptive data.

3. As for the limitation of "receiving, at said server system, a first signal from a first client system **indicating** a request to submit said first invention disclosure for approval" only require that a signal be sent. What the signal indicates to a receiver does not affect the steps of the method or the structure of the system.

4. As for the limitation as to claim 2, "wherein said message is an alert that, **when read, allows** said second client system to select to approve or disapprove preparation of a patent application for said invention disclosure and wherein after said second client system makes a selection, stores said selection in said database", the Examiner notes that there is not positive recitation of the alert being read. Furthermore, allowing a system to select to approve or disapprove is not a positive recitation. Allowing something to happen does not mean that it happens.

Moreover, claim 3 is directed to a conditional statement which is dependent on claim 2. Claim 3 is directed to "if" the client system selects to approve. There again, there is no positive recitation of a selection be made.

5. As to claim 4, the fact that the second message is communicated to a third client system ***associated with a patent law firm*** is non-functional descriptive data. The fact that a computer is associated with a firm does not impact the steps of the method or the structure of the system.

Referring to Claim 5:

Serbinis discloses wherein the server system includes an access management system that assigns client systems to one or more user groups and assigns data and documents stored in the database to one or more user groups and wherein access management system allows a client system connected to the server system to access data/documents if the client system is assigned to the same groups as the data/document (col. 3, lines 32-34; col. 7, lines 18-21; col. 7, line 63 thru col. 8, line 1;

col. 8, lines 10-17; col. 8, line 64 thru col. 9, line 3 and col. 9, lines 19-22; col. 12, lines 24-42; Figure 2).

Referring to Claims 11-12:

Serbinis discloses wherein said message includes a link to documents (col. 1, lines 36-42 e-mail message with direct reference (i.e., URL) to electronic document stored on a server; col. 1, line 63 thru col. 2, line 9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Serbinis et al (US Patent 6,584,466) (hereinafter referred to as Serbinis) as applied to claim 1 and further in view of Takano et al (US 6,434,580) (hereinafter referred to as Takano).

Referring to Claim 6:

While Serbinis discloses wherein the server system includes an access management system that assigns client systems to one or more user groups and assigns data and documents stored in the database to one or more user groups and wherein access management system allows a client system connected to the server

system to access data/documents if the client system is assigned to the same groups as the data/document, Serbinis does not disclose that the systems are associated with first technology developers.

However, Takano discloses wherein the first and second client systems are associated with a first technology developer and assigned by the server system to a first user group (*col. 1, lines 8-17 a method and system for preparing patent specifications with inventors and persons in charge of filing patent applications **using a plurality of computers connected to a communication network**, such as the Internet, for preparing patent specifications for patent applications; col. 5, lines 55-61 the draft preparation means 101 is used by an employee or the like of a company (hereinafter referred to as an inventor) to report on an invention by the inventor as part of his or her duty in the company to department of the company responsible for patent application processing*), said invention disclosure is part of a Case Data Unit assigned to the first user group (*col. 8, lines 14-20 **displays on a display unit (not shown) a list of all the pieces of invention report information registered in this table 304 (or only those satisfying specific conditions [e.g. only those pertaining to inventors belonging to a specific department])***), the third client system is assigned to a second user group different from the first user group (*col. 6, lines 5-15 the client computer 200 is used by a person of the patent application processing department of a company or a person of a patent attorney's office requested by the company to file a patent application*) and in response to the second client system approving preparation of the patent application the server system also assigns the invention disclosure to the

second group (Figures 3-5, 14, 17 and col. 3, line 32 thru col. 4, line 55; See col. 7, line 54 thru col. 24 -

*Referring to FIG. 4, the table 304 consists of a plurality of entries for registering plural pieces of invention report information, and each entry consists of fields 21 to 26 in which items constituting a **piece of invention report information including a reference number, the title of the invention, the inventor's name, his or her employee ID number, assigned department and telephone numbers are registered, a field 27 in which the storage address of draft data pertaining to that particular piece of invention report information in the specification file 303 is registered. Another specific example of registration processing at step A8 is conceivable, in which a piece of invention report information and draft data are put together and stored into a single directory (file), and this file, to which a directory (file) name enabling both the inventor using the client computer 100 and the patent-application-filing persons using the client computer 200 to identify the draft data, e.g. the reference number contained in the pertinent piece of invention report information, is assigned, is registered in the specification file 303. Upon registration of the draft data for the specification for patent application and the pertinent piece of invention report information into the server computer 300 as described above, the patent-application-filing persons are enabled to revise the draft data on the client computer 200. When the draft is to be revised, first the draft downloading means 201 of the computer 200 references the specification file management table 304 in the***

*specification file 303 of the server computer 300; **displays on a display unit (not shown) a list of all the pieces of invention report information registered in this table 304 (or only those satisfying specific conditions [e.g. only those pertaining to inventors belonging to a specific department])** (step A9); lets the patent-application-filing persons select a desired piece of invention report information; finds the storage address of the draft data pertaining to the selected piece of invention report information from the specification file management table 304; and reads the draft data from the specification file 303 on the basis of that address (step A10).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into document management method and system of Serbinis the use of the method and system by technology developers with user groups taught by Takano as a way of providing a document management system and method for the collaborative preparation of patent applications with parties only able to access only those patent application that pertain to a certain group, such as inventors belonging to a specific department.

Referring to Claim 7:

Serbinis discloses workflow rules (*Figure 2, (61) and col. 6, lines 19-46*

Referring to FIG. 2, DMS database 25 is described in greater detail.

Database 25 includes a plurality of tables 61-64 and 66-68 that maintain information on documents stored in store 30. Each of tables 61-64 and 66-68 may in turn consist of multiple tables. Document information tables 61 have

*entries for a number of document-related parameters, including: information on a document's parent document group; information on the document instances; information on the transport method to be used for retrieval of a document instance; information on the priority of the document; expiration information: the date and time when a document instance is changed from "active" status to "archived" status; **workflow information for a document instance; security information; document rights; and document group rights.** User information tables 62 have entries for information relating to users registered to access and use the DMS system, including: the name of the user; logon information for the user, e.g., user ID and password; user notification information, e.g., notification address and transport type; billing code information; information on the user's account, where each user account is unique to a service account and user; user session information; and **user group information, i.e., information on the group of users that the user is a part of, including the name of the group, the state of the group, the group's security information, and document rights for the group).***

Serbinis discloses user group information. Serbinis does not disclose that the rules are associated with a technology developer.

However, Takano discloses the association with the technology developer (Figure 3 and col. 7, lines 11-27, Figure 4 and col. 7, line 52 thru col. 8, line 24 displays on a display unit a list of all the pieces of invention report information registered in this table 304 (or only those satisfying specific conditions [e.g. only those pertaining to inventors belonging to a specific department]; col. 10, lines 8-29).

Referring to Claim 10:

Takano discloses wherein the first client system creates the invention disclosure under the guidance of pages generated by the system (col. 6, line 44 thru col. 7, line 26 input screen; col. 7, line 52 thru col. 8, line 6; col. 9, lines 14-21 template data).

Response to Arguments

Applicant's arguments with respect to claim 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Application/Control Number:
09/996,077
Art Unit: 3629

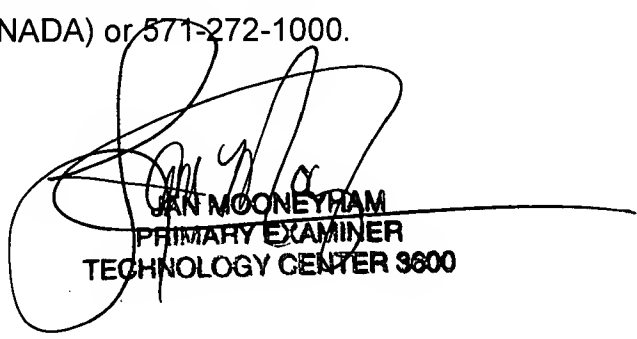
Page 14

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JM



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